REMARKS

This is a full and timely response to the Office Action of August 29, 2008 (the "Office Action" or "Action"). Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Claims 18-23, 45 and 46 have been cancelled previously without prejudice or disclaimer. Claims 1-17 and 24-44 remain pending for further action.

Allowable Subject Matter:

In the recent Office Action, the Examiner indicated the presence of allowable subject matter in claims 16 and 35. Applicant wishes to thank the Examiner for this identification of allowable subject matter.

Applicant agrees with the Examiner's conclusions regarding the patentability of these claims, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the claims or claimed subject matter may be paraphrased.

Prior Art:

Claims 1-4, 6, 9-15, 17, 24-27, 29-34, 36-38, 41 and 42 were rejected under 35 U..S.C. §103(a) over the combined teachings of U.S. Patent No. 5,666,293 to Metz et al. ("Metz") and U.S. Patent No. 5,247,364 to Banker ("Banker"). Applicant respectfully

traverses this rejection for at least the following reasons. Applicant further submits, in the interest of compact prosecution, that it is extremely unfortunate that Applicant should have to appeal a rejection of these claims, have the Board of Patent Appeals reverse that rejection, and then face these new grounds of rejection which are similarly unfounded, as Applicant demonstrates below.

Claim 1 recites:

> A set-top terminal for connecting a subscriber to a cable network, said terminal comprising:
> a processor; and
> a memory unit,
> *wherein the processor monitors an out-of-band control channel of the cable network for information indicating that a download of data or programming is available and indicating a specified in-band channel for receiving the download of data or programming offered to said set-top terminal over said cable network*, wherein said processor only accepts said download on said specified in-band channel and records said download in said memory unit when one or more predetermined criteria are satisfied, and wherein said criteria when satisfied indicates that acceptance of said download will cause a minimum of interference with said subscriber's use of said set-top terminal.

(Emphasis added).

Claim 24 similarly recites "receiving a signal from a headend identifying a specified in-band channel on which said download is available, wherein the received signal is obtained via an out-of-band control channel of the cable network." Claim 36 similarly recites "receiving a signal from a headend identifying a specified in-band channel on which said download is available, wherein the received signal is obtained via an out-of-band control channel of the cable network." Claim 41 similarly recites a processor "dedicated to monitoring an out-of-band channel for information indicating that a download of data or programming is available, indicating a specified in-band channel for receiving the download, and managing a download

of data or programming offered to said set-top terminal over said cable network through the specified in-band channel."

The recent Office Action concedes that "Metz fails to disclose the processor monitors an out-of-band control channel of the cable network for information indicating that a download of data or programming is available and indicating a specified in-band channel for receiving the download of data or programming." (Action, p. 3). Accordingly, the Action cites to Banker on this point. As construed by the Action, Banker teaches "messages, which are received via a dedicated out of band channel, col. 2, lines 55-68, control the set-top box to automatically tune to a specified in-band channel to receive data which is addressed to the terminal, col. 8, lines 10-47." (Action, p. 3). This is clearly and demonstrably incorrect.

Contrary to the assertion of the Office Action, Banker never teaches a out-of-band control message "indicating a specified in-band channel" on which to receive a "download of data or programming offered to said set-top terminal over said cable network." As cited in the Office Action, Banker teaches the following.

> Addressable transmitter 208 transmits data to out-of-band subscriber terminals via a dedicated FM data channel such as a 108.2 megahertz data channel in the cable television distribution system. This channel, known as the data carrier, is used to transmit both addressable commands intended for a particular out-of-band subscriber terminal and global commands intended for all out-of-band subscriber terminals in the system. Out-of-band subscriber terminals contain a receiver that is listening to the commands sent over this data channel. Unlike the in-band transactions described in detail below, out-of-band subscriber terminals receive data over this channel no matter what channel the subscriber terminal is tuned to.

(Banker, col. 2, lines 55-68).

Thus, a "data channel" is an out-of-band channel "used to transmit both addressable commands intended for a particular out-of-band subscriber terminal and global commands intended for all out-of-band subscriber terminals in the system.

The other portion of Banker cited states the following.

> A message definition transaction transmission is depicted in FIG. 5B. An ID field identifies this transaction transmission as a message definition. This transaction transmission indicates that a message has been sent to the subscriber terminal. The messages may be individually addressed or addressed to members of a group of subscriber terminals defined by the address data. Using a separate downloaded transaction, a subscriber terminal can be assigned to one or more groups. In a preferred embodiment, 64 groups are defined, but the invention is not limited in this respect. The message definition transaction transmission includes a background color field for setting the background color of the on-screen display and *a tuning field which instructs the terminal which data channel to tune to receive the message*, which in this example, is the message channel. When a subscriber terminal receives a message definition transaction transmission which is addressed to it or to any group of which it is a member, a message alert may be provided in accordance with the alert data field. The subscriber may view the message by use of a menu structure described in the above-mentioned commonly assigned application entitled "Method and Apparatus for Providing an On-Screen User Interface for a Subscription Television Terminal". In order to obtain the message, data and control circuit 402 of the subscriber terminal tunes up/down converter 401 to the channel defined by the tuning field and searches for a message transaction transmission with the same display number as in the message definition transaction transmission. *In a preferred embodiment, the tuning data instructs the subscriber terminal to tune either the channel currently tuned, one of the message channels, the scroll channel, or the OFF channel to retrieve the appropriate message*. The message definition transaction transmission of FIG. 5B is preferably sent on all data streams output by headend controller 203 in order to most quickly inform a subscriber that he or she has a message.

(Banker, col. 8, lines 10-47) (emphasis added).

Thus, Banker only appears to teach tuning out-of-band channels to retrieve messages. There is nothing here that teaches or suggests that information received on an out-of-band channel "indicat[es] a specified in-band channel for receiving the download of data or programming offered to said set-top terminal over said cable network." (Claim 1).

The Office Action fails to make a *prima facie* case of obviousness as to claim 1 and the other similar claims in that the Office Action fails to accurately determined the differences between the cited prior art and the claimed subject matter as demonstrated here. Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an

assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art.

In the present case, the scope and content of the prior art, as evidenced by Metz and Banker, did not include the claimed subject matter, particularly a set-top terminal that receives information on an out-of-band channel that "indicat[es] a specified in-band channel for receiving the download of data or programming offered to said set-top terminal over said cable network." (Claim 1). This subject matter is entirely outside the scope and content of the cited prior art.

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claims 1, 24, 36 and 41, and their respective dependent claims, under 35 U.S.C. § 103 and *Graham*. Moreover, it is particularly disappointing that this prior art, which does not even support a *prima facie* case of obviousness is cited after the Applicant has had to successfully appeal a previous rejection based on equally inapposite prior art.

Claims 5 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz in view of Banker and U.S. Patent No. 5,373,557 to Diehl et. al. ("Diehl"). This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the corresponding independent claims.

Additionally, claim 5 depends from claim 1 (addressed above) and recites "wherein said one or more criteria include a time of day." Claim 28 recites similar subject matter. The Office Action concedes that Metz and Banker fail to teach or suggest using "time of day" as a

criterion for accepting a download of new data or programming. (Action, p. 11). Adding Diehl does not remedy this deficiency.

Diehl only teaches a system that activates a decoder during a specified time of day to receive entitlements (Col. 1, lines 55-60). Diehl routinely activates the decoder at a specified time of day on a regular basis. Diehl does not teach or suggest using time of day as a criterion to be considered in deciding whether to take a particular action, such as accept a data download as claimed. Neither Metz, Banker nor Diehl teach or suggest using time of day as a criterion indicative of subscriber convenience for deciding whether to accept a download of programming for operating a set-top terminal.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Metz, Banker and Diehl, did not include the claimed subject matter, particularly "wherein said one or more criteria [for accepting a download] include a time of day."

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claims 5 and 28 under 35 U.S.C. § 103 and *Graham*.

Claims 7, 8, 39 and 40 were rejected under 35 U.S.C. §103(a) over the combined teachings of Metz, Banker and U.S. Patent No. 6,047,317 to Bisdikian ("Bisdikian"). This

rejection should not be sustained for at least the same reasons given above in favor of the patentability of the corresponding independent claims.

Claims 43 and 44 were rejected under 35 U.S.C. §103(a) over the combined teachings of Metz, Banker and Bisdikian. For at least the following reasons, this rejection should not be sustained.

Claim 43 recites:

> A set-top terminal for connecting a subscriber to a cable network, said terminal comprising:
> a processor; and
> a memory unit,
> wherein the processor monitors transmissions over said cable network for information indicating that a download of data or programming is available and indicating a specified channel for receiving the download of data or programming offered to said set-top terminal over said cable network, wherein said processor only accepts a download and records said download in said memory unit when one or more predetermined criteria are satisfied that indicate that acceptance of said download will cause a minimum of interference with said subscriber's use of said set-top terminal; and
> *wherein said one or more criteria include a deadline by which acceptance of said download is required by an operator of said cable network, said deadline being a specific point in time subsequent to an initial offering of said download of data or programming.*

(Emphasis added).

In contrast, the Action concedes that "Metz and Banker fail to disclose wherein said one or more criteria include a deadline by which acceptance of said download is required by an operator of said cable network, said deadline being a specific point in time subsequent to an initial offering of said download of data or programming." (Action, p. 16). Consequently, the Action cited to Bisdikian on this point.

According to the Action, "Bisdikian discloses a data carousel wherein the receiver is provided with information which specifies a deadline for accepting information from the carousel, said deadline being a specific point in time subsequent to an initial offering of said

download of data or programming." (Action, p. 16). This is a gross mischaracterization of what Bisdikian teaches.

Bisdikian does teach a data carousel. However, there is no "deadline by which acceptance of said download is required by an operator of said cable network." Rather, Bisdikian merely teaches that the data carousels indefinitely so as to be available, after a possible latency, when needed by a receiver. (Bisdikian, col. 3, lines 59-63). The Office Action unfairly and improperly reads subject matter into Bisdikian that simply isn't there. Bisdikian never mentions, teaches or remotely suggests a deadline set by the operator of a cable network by which a download of data is required. The Office Action is unable to point to any such teaching in Bisdikian.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Metz, Banker and Bisdikian, did not include the claimed subject matter, particularly the claimed set-top terminal configured to respect "a deadline by which acceptance of said download is required by an operator of said cable network, said deadline being a specific point in time subsequent to an initial offering of said download of data or programming."

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 43 under 35 U.S.C. § 103 and *Graham*.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

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